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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,459	01/22/2002	Hans Beer	2265/50685	6980

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EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,459

Applicant(s)

BEER ET AL.

Examiner

Lyle A. Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Beer et al.(USP 5,628,960) or Johnson (USP 4,894,157).

Beer et al. teach process for producing cellulose membranes by casting the cellulose directly on a film. Column 3 lines 45+ teach removing impurities, such as dust, by the addition of water and methanol prior to the drying. The methanol has been read on the limitation of claim 14 "... alcohols containing from 1 to 6 carbons...". Column 3 lines 8+ teach addition of wetting agents or surfactant are introduced into the membranes during casting or injected afterwards. Beers et al. teach pore sizes in the range of 0.45-15 microns that has been read on the claimed range of 0.01-12 microns and greater than 0.45 microns (e.g. in light of the 35 USC 112 second paragraph issues above this range has been read as 0.45-12 microns).

Johnson teaches a process of producing a cellulose membrane. Column 2 lines 48 through column 3 lines 6 teach the use of wetting agents. Column 4 lines 44+ through column 5 teach forming the membrane by phase inversion. Column 7 lines 7+ teach a rinse of water and alcohols to remove contaminant have been read on the claimed "removing impurities" and claim 14. Column 4 lines 39-43 teach pore size of 0.1-5.0 microns which reads on the claimed range of 0.01-12 microns and greater than 0.45 microns (e.g. in light of the 35 USC 112 second paragraph issues above this range has been read as 0.45-12 microns).

Response to Arguments

Applicant's arguments filed 2/7/05 have been fully considered but they are not persuasive.

Applicants state the instant invention is directed to a method of removing impurities from a newly formed membrane after the membrane is completely dried. The remarks are not commensurate in scope with the instant claims (e.g. " ... prior to drying the resulting feedstock membrane, removing impurities ...") which do not claim removing impurities from a newly formed membrane as characterized by Applicants.

Applicants state Beer et al. does not remove dust after the membrane has been formed. These remarks are not commensurate in scope with the instant claims which do not require the argued limitation.

Applicants argue Johnson is non-analogous art because it is not directed to a diagnostic assay device as presently claimed. The instant claims do not contain any elements that would limit the invention to a diagnostic device. Rather, the instant claims are directed to a method of producing a membrane which is indistinguishable from the teachings of Johnson. Further, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the instant case Johnson is in the same field of endeavor (e.g. a membrane).

Applicants also remark the instant invention is not directed to a membrane that permits dust to pass through as taught by Johnson but rather a "no flow through membrane". These remarks are not commensurate in scope with the instant claims that contain no limitations to the flow properties of the membrane.

Applicants state Johnson fails to meet the instant limitations "... prior to drying the resulting feedstock membrane, removing impurities ...". These remarks are not commensurate in scope with the instant claims. Johnson clearly teaches removal of impurities prior to drying of the membrane.

Finally, Applicants argument that Johnson does not teach removal of "dust" from the surface is not commensurate in scope with the pending claims. The claims are directed to "impurities" which have been properly read on Johnson's removal of "residual....". Further, Applicants' statement that Johnson does not teach removal of dust conflicts with Applicants characterization of Johnson in the last line of the first full paragraph on page 15 that states "... the dust pass through the pores..." of the membrane taught by Johnson.

Applicants' traverse the 5/10/04 restriction requirement . The restriction requirement was traverse and made final in the 10/7/04 Office action. Applicants state the invention of group III cannot produce a membrane with an unrefined surface. In the absence of better defining what is intended by a refined surface, the Office maintains the invention of group III can produce a membrane with a contaminated surface (e.g. contamination has been interpreted as "unrefined") and has been properly restricted

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from groups I,II. The Office may reconsidered the restriction requirement between groups I and II upon the allowance of group I provided group II contains the limitations that made group I allowable.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander
Primary Examiner
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